

**REMARKS**

The Office Action dated March 1, 2010 has been received and reviewed. Claims 1 to 9 and 12-19 are pending in the application. Claims 1-9 and 12-19 are rejected. Claims 18 and 19 are currently cancelled. Claim 20 is new.

Claim 1 is currently amended to replace “from the sample” with “in the sample”, as discussed below.

Claim 1 is currently amended to recite “one or more selected antimicrobial(s)” and “wherein the selected antimicrobials are selected based on the results of step (a)”. Support for the amendments can be found in the application in original claim 12, for example.

Claim 1 is currently amended to recite a feature wherein determining the effect of one or more selected antimicrobial(s) comprises a plurality of steps involving aliquots of the original sample. Support for the amendment can be found in the application on page 12, lines 22-30, for example.

Support for new claim 20 can be found in the application on page 5, lines 7-10, for example.

**Rejection Under 35 USC 112**

Claims 18 and 19 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement.

Claims 18 and 19 are canceled without prejudice. Applicant expressly reserves the right to enter claims 18 and/or 19 in a continuing application.

Claims 1-9 and 12-19 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant thanks the Patent Office for pointing out the discrepancy in the use of “from the sample” in one part of claim 1 and “in the sample” in another part of claim 1. The Patent Office asserts that *from the sample* “implies that the microorganisms are separated from the sample” and that *in the sample* “implies that the microorganisms are not separated from the sample”. Applicant believes that a person of ordinary skill in the art would understand that both phrases refer to the origin of the microorganisms (i.e., the sample). Applicant further believes that the microorganisms cannot be separated from the

sample, per se, because they are a part of the sample. However, a person of ordinary skill in the art will instantly recognize that, in some embodiments, the microorganisms may be separated from a portion of the original sample (e.g., other microorganisms), as disclosed in the application on page 6, line 26 through page 7, line 2, for example.

In the interest of advancing prosecution, Applicant amends claim 1 to recite the phrase, “two or more different micro-organisms in the sample”, wherein the phrase refers to the *origin* of the microorganisms (i.e., the sample).

### Rejection Under 35 USC 103

Claims 1-3, 8-9 and 12-18 are rejected under 35 USC 103(a) as being unpatentable over Peck et al. US 5,789,173, in view of Kohne et al. US 5,738,988.

The current amendment to claim 1 moots the rejection because the combination of documents does not teach or suggest all of the features of the amended claim 1. Neither Peck et al. nor Kohne et al. teach or suggest the selection of antimicrobials based on the results of the identification step. Therefore, amended claim 1 is patentable over Peck et al., in view of Kohne et al. Claims 2, 3, 8, 9, and 12-18 each add additional features to claim 1 and are likewise patentable over Peck et al. in view of Kohne et al. Withdrawal of the rejection of claims 1-3, 8-9 and 12-18 under 35 USC 103(a) as being unpatentable over US 5,789,173, in view of US 5,738,988 is respectfully requested.

Claims 4-7 are rejected under 35 USC 103(a) as being unpatentable over Peck et al. US 5,789,173 and Kohne et al. US 5,738,988 as applied to claims 1-3, 8-9 and 12-18 above, further in view of Grondahl et al. Journal of Clinical Microbiology, Jan. 1999, p. 1-7.

Claims 4-7 each add additional features to claim 1. Claim 1 is patentable over Peck et al. in view of Kohne et al. for at least the reasons discussed above. Grondahl et al. do not teach or suggest the selection of antimicrobials based on the results of the identification step. Therefore, claims 4-7 are patentable over Peck et al. and Kohne et al. as applied to claims 1-3, 8-9 and 12-18 above, further in view of Grondahl et al. Withdrawal of the rejection of claims 4-7 under 35 USC 103(a) as being unpatentable over Peck et al. US 5,789,173 and Kohne et al. US 5,738,988 as applied to claims 1-3, 8-9 and 12-18 above, further in view of Grondahl et al. Journal of Clinical Microbiology, Jan. 1999, p. 1-7 is respectfully requested.

Claims 4-7 are rejected under 35 USC 103(a) as being unpatentable over Peck et al. US 5,789,173 and Kohne et al. US 5,738,988 as applied to claims 1-3, 8-9 and 12-18 above, further in view of Van Elden et al. The Journal of Clinical Microbiology, Jan. 2001, p. 196-200.

Claims 4-7 each add additional features to claim 1. Claim 1 is patentable over Peck et al. in view of Kohne et al. for at least the reasons discussed above. Van Elden et al. do not teach or suggest the selection of antimicrobials based on the results of the identification step. Therefore, claims 4-7 are patentable over Peck et al. and Kohne et al. as applied to claims 1-3, 8-9 and 12-18 above, further in view of Van Elden et al. Withdrawal of the rejection of claims 4-7 under 35 USC 103(a) as being unpatentable over Peck et al. US 5,789,173 and Kohne et al. US 5,738,988 as applied to claims 1-3, 8-9 and 12-18 above, further in view of Van Elden et al. The Journal of Clinical Microbiology, Jan. 2001, p. 196-200 is respectfully requested.

Claims 7, 9 and 19 are rejected under 35 USC 103(a) as being unpatentable over Peck et al. US 5,789,173 and Kohne et al. US 5,738,988 as applied to claims 1-3, 8-9 and 12-18 above, further in view of De Baere et al. BMC Microbiology March 2, 2002, 2:4 (p. 1-12).

Claim 19 is currently canceled. Claims 7 and 9 each add additional features to claim 1. Claim 1 is patentable over Peck et al. in view of Kohne et al. for at least the reasons discussed above. De Baere et al. do not teach or suggest the selection of antimicrobials based on the results of the identification step. Therefore, claims 4-7 are patentable over Peck et al. and Kohne et al. as applied to claims 1-3, 8-9 and 12-18 above, further in view of De Baere et al. Withdrawal of the rejection of claims 4-7 under 35 USC 103(a) as being unpatentable over Peck et al. US 5,789,173 and Kohne et al. US 5,738,988 as applied to claims 1-3, 8-9 and 12-18 above, further in view of De Baere et al. BMC Microbiology March 2, 2002, 2:4 (p. 1-12) is respectfully requested.

All outstanding objections and rejections are believed to have been met and overcome. If a telephonic conference with Applicants' undersigned representative would be useful in advancing the prosecution of the present application, the Examiner

is invited to contact the undersigned at (651) 736-7430. A notice of allowance for all pending claims is respectfully solicited.

Respectfully submitted,

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